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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,100	06/01/2001	Ondrej Mikla	WSO 37992	3104

7590 07/17/2003
LERNER AND GREENBERG, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480

EXAMINER

BHAT, NINA NMN

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,100

Applicant(s)

MIKLA ET AL.

Examiner

N. Bhat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeffcoat et al.

Jeffcoat et al. teach the invention substantially as claimed. Jeffcoat et al. teach using stabilized or stabilized cross linked waxy potato starch in foods which provides improved thickening using less starch than if other starches were used. Specifically, Jeffcoat et al. teach using waxy potato starch, which is a potato starch, which is high in amylopectin. The waxy potato starch is useful in foods and differs in functionality from starches having high amylose content. The use of waxy potato starch which is high in amylopectin where amylose is specifically suppressed used in foodstuff discourages reassociation so that gelling does not readily occur and the resulting pastes are more flowable and clear than when using high amylose starches. Jeffcoat et al. teach that certain stabilized and cross linked waxy potato starches have unexpectedly high viscosities such that they can provide a desired viscosity to a composition while using substantially less starch than would be needed if using a conventional starch thickener or viscosifier. [Note Column 1, lines 27-63 and Column 2, lines 30-35] Jeffcoat et al. teach that the modified waxy potato starch (which is a cross-linked potato starch) can be used in food applications as a thickener or viscosifier, and can include any edible

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food product including dressings, spoonable dressings, pie fillings, fruit and cream fillings, white sauces, gravies, cheese sauces, lite syrups, puddings, custards, yogurts, sour creams, beverages, glazes and soups. The modified waxy potato starch can be used in foods, which are intended to undergo various processing, retorting aseptically packaging, freezing and refrigeration. The starch has good optical clarity and can be used in clear food stuffs such as broths, syrups and fruit fillings yielding a cohesive texture.

However, Jeffcoat et al. does not teach the amylopectin content of the starch nor does Jeffcoat et al. teach intensifying the pulpy or gritty texture of the product.

As described above Jeffcoat et al. teaches providing a stabilized hydroxypropylated cross-linked waxy potato starch, which is used in foodstuffs as a viscosifier or thickener. The waxy potato starch as described by Jeffcoat et al. is a high in amylopectin starch and Jeffcoat et al. recognizes that the potatoes used in making the starch are genetically altered to suppress amylose production and specifically teaches that the waxy potato starch is low in amylose and high in amylopectin. One of ordinary skill in the art would recognize that the high in amylopectin would be a waxy potato starch having a high content of amylopectin of at least 95% absent criticality in showing. With respect to the applicant's recitation of intensifying the pulpy or gritty texture of pasty foodstuff, these properties of pulpy and gritty are properties, which are not quantitatively measured and are "organoleptic" properties, which are dependent upon the taster or individual. Jeffcoat et al. teaches the using a modified cross-linked waxy potato starch in foods is known and that the waxy potato starch supercedes the prior art

Application No. 09/894,677. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are used in adding amylopectin potato starch having an amylopectin content of at least 95% to the foodstuff. The amylopectin potato starch is derived from potatoes wherein the potatoes have been modified to suppress an amylose content of the potatoes. Admittedly, in the 09/894,677 the claims are to a method of providing a foodstuff which contains potato starch high in amylopectin which is subsequently baked or fried, the method of the '677 applicant can read on a process wherein the potato starch is added in an amount sufficient to cause an organoleptic change of the foodstuff which would inherently improve or intensify the pulpy texture or thickening of a foodstuff which would be an obvious if not inherent characteristic of the addition of adding potato starch thus not patentably distinct from the 09/873,100 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. GB 2 347 840 teaches a snack food comprising high amylopectin potato flakes and/or granules. Tallberg et al. teach genetically engineered modification of potato to obtain an amylopectin starch. Buwalda et al. teach a heat stable high amylopectin starch used in the baking industry for creams, fruit fillings, and toppings as a binder or thickening agent.

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starches in many ways by thickening a foodstuff using less starch and does not experience the problems of gelling as other starches, the modified waxy potato starch unexpectedly can be used in clear broths and filling where clarity is required. The use of less starch in food products also reduces the amount of masking ingredients required when using conventional starches. Jeffcoat et al. teach that the waxy potato starch can be used in any type of foodstuff such as sauces, gravies, soups, fillings, custards etc. and to use the modified waxy potato starch of Jeffcoat et al. in ketchup or mashed potatoes would have been obvious to one having ordinary skill in the art. It is maintained that the teachings of Jeffcoat et al. renders applicant's invention as a whole obvious and provides a method of improving the organoleptic properties of a foodstuff by the addition of a modified waxy potato starch when compared to conventional potato starch or waxy maize starch.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

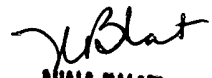
Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending

Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-4039. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872- for regular communications and 703-872- for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0779.

July 12, 2003


NINA BHAT
PRIMARY EXAMINER
GROUP 1200-1700